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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,403	09/24/2003	Viacheslav A. Petrov	UC0315 US NA	5058

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E I DU PONT DE NEMOURS AND COMPANY
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WILMINGTON, DE 19805

EXAMINER	
VIJAYAKUMAR, KALLAMBELLA M	
ART UNIT	**PAPER NUMBER**
1793	

NOTIFICATION DATE	DELIVERY MODE
11/30/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary	Application No.	Applicant(s)	
	10/669,403	PETROV ET AL.	
	Examiner	Art Unit	
	Kallambella Vijayakumar	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09/05/2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15 and 22-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15 and 22-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- Claims 15, 22 and 23 were amended. Claims 24-32 were newly added. Claims 15 and 22-32 as amended are currently pending with the application.
- Applicants amendment overcomes the rejection under 35 USC 103(a) over Poetsch et al (US 5,196,140) in view of either Koden (US 5,271,867) or Mercer et al (US 5,179,188).

Claim Objections

Claims 23 and 30-32 objected under 37 CFR 1.75 as being a substantial duplicate of claims 15 and 24-26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The claims are almost similar because Rm and Xn in the formulas contain m and n values of m=0 and n=0, and a range of $m+n \leq 5$ that includes values ranging from 0-5 making the substituents an optional components and in turn the claims to be substantial duplicates.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 15, 23-26 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Babb et al (US 5,730,922).

The use of phrase "for depositing an active material on to a surface" in the claims have not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

The prior art teaches a coating composition comprising: (a). Monomers/prepolymers of the structure CF_2=CF-X-R-(X-CF=CF_2)$_m$, wherein m=an integer from 1-3; X= O-atom or a perfluoroalkylene ether; and R=aromatic and substituted aromatic, with C_1-C_{12} atoms and a molecular weight from 14-20,000; (b). barium ferrite or iron oxide or titania < semiconductor/active material>, and (c). a solvent, which are applied to a surface by either solution deposition or Langmuir-Blodgett technique (Col-4, Ln 51- Col-5, Ln 5; Col-5, Ln 45-Col-6, Ln 10; Col- 14, Ln 30-40; Col-15, Ln 12-43). The substitutents Rm and Xn in the formulas of these claims are optional components wherein m=0 and n=0, and further a range of m+n <5 includes a values ranging from 0-5. With regard to the properties in the claims the prior art composition is either same or substantially same as that claimed by the applicants, and possess same characteristics. All the limitations of the instant claims are met.

The reference is anticipatory.

2. Claims 15 and 22-32 rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al (US 6,046,348).

The use of phrase "for depositing an active material on to a surface" in the claims have not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Yamada et al teach coating a charge-transport layer of an electrophotographic photoreceptor from a coating solution containing a transport material such as hydrazone, a charge generating material such as a phthalocyanine compound <photo/electro active materials>, a silane compound and a fluorine containing polymer such as a fluoro-containing ethers such as 1,1,2,2,-tertafluoroethyl ether (Cl-73, Ln 1-8, 18-21, 43-57; Cl-74, Ln 22-36, particularly 27-28). With regard to the properties in the claims the prior

art composition is either same or substantially same as that claimed by the applicants, and possess same characteristics. All the limitations of the instant claims are met.

The reference is anticipatory.

Response to Arguments

Applicant's arguments filed 09/05/2007 have been fully considered but they are not persuasive. In response to applicant's argument that Babb discloses several solvents, but does not disclose the None of these or suggest fluorinated substituents on the species containing an aromatic ring, and None of these solvents read on the claimed solvents is not persuasive, because Babb's monomers read on the claimed composition, and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the reasons set forth above, applicants fail to patentably distinguish their composition over the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 6.30-4.00 Mon-Thu, 6.30-2.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KMV/
Nov 24, 2007.

STANLEY S. SILVERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700